

REMARKS

Claims 83 - 103 are pending. Claims 1 – 82 were previously canceled.

The claims were rejected based on Bradshaw (US Patent No. 5,835,722) under §102(e). This rejection is traversed as explained in more detail below.

Claims 83, 84, 87, 92, 94, 96, 100 and 101 are patentable over Bradshaw

The Examiner apparently does not disagree with the Applicant's explanation that in Bradshaw the only "filtering" of the *author's* creation of content is done at the keyboard queue level, so it cannot meet this language of the claims. This was explained in detail with reference to the "XSTOP keyboard queue" discussion in Bradshaw.

The Examiner now points to a couple of other different aspects of Bradshaw, namely: (1) a manual email inspection feature (described at col. 7); and then (2) a feature discussed in passing (in col. 12, ll. 45+) that compares content in emails with the libraries. While these discussions bear some superficial resemblance to the claims, they still fail to meet the language of the claims for several reasons.

As concerns the Examiner's first citation, the discussion at col. 7 of Bradshaw mentions an inspection feature that the supervisor must invoke to manually/visually inspect an email in person:

Selecting "Review" presents a pull-down menu with the choices "E-mail" and "Exit". Selecting "E-mail" presents a submenu with the choices, "Mail In" and "Mail Out". Selecting "Mail In" opens the log file of all incoming E-mail. Presented is a list of messages, any of which may be opened for reading, saved to a separate file, or deleted from the list. Selecting "Mail Out" opens the log file of all outgoing E-mail and presents a similar screen to open, save, or delete the messages. The supervisor can at this point note any E-mail addresses for addition to the Library of blocked E-mail addresses.

The description goes on to explain that the supervisor can "add" words to the language filters based on this manual inspection of the email. So this aspect of the disclosure is not describing an "...*electronic text editor program operating on a computing system*" that is "... *inspecting said input words within the email message file to determine if they fall within said language filter.*" Rather, all that is happening is that the Supervisor is given an administrative "Review" tool that permits him/her to manually review emails and

then construct a library and email messages/email address black list. This is no different than any prior art system that would permit a user to review their email, so it does not contribute anything vis-à-vis the automated steps of claim 1 performed by the computing system in which the words are inspected to see *if* they fall within the language filter, alerting the author if they fall within the filter, etc. Moreover as the Examiner can see, this review feature of Bradshaw is not integrated or part of the main sentinel keyboard character queue/interceptor – instead it is an ancillary tool used to construct the libraries and domain black lists. Thus it does not add up to the claimed combination.

Under the standards for anticipation, the Examiner must establish a prima facie case under § 102 by showing, as a matter of fact, that a single reference describes to one skilled in this art each and every limitation of the claimed invention encompassed by the claim, arranged as required therein, either explicitly or inherently. See, e.g., In re Schreiber, 128 F.3d 1473, 1477 (Fed. Cir. 1997), and cases cited therein; In re Bond, 910 F.2d 831, 832-33 (Fed. Cir. 1990), and cases cited therein. The facts above show that Bradshaw simply does not show the arranged limitations of the claim particularly as concerns several author-related features. Instead the Examiner is picking out unrelated aspects of the disclosure, and trying to sum them together when they are not set out that way in the first place.

As to the second area pointed out by the Examiner in Bradshaw in col. 12 Applicant again points out that this does not describe anything that can meet the language of claim 83. The description is very cursory and makes no mention of any of these steps:

“...permitting *the author* to select at least one language filter”

“...alert[ing] *the author* when one or more of said input words within the email message file fall within said language filter”

“...permit[ting] *the author* to change words within the email message file after step (d) and before the email message file is transmitted to said intended recipient...wherein the author of the email message file can cause the email message file to be transmitted by the computing system to said intended recipient even if words in such email message file still fall within said language filter”

Take the simple example of an *incoming* email message for Bradshaw. The author/originator of this type of email message is outside the Bradshaw environment and has no access to any of the features or capabilities identified above in claim 83. For one thing they have already sent the message, and therefore can no longer control its

distribution. So Bradshaw offers no solution to this type of problem.

For *outgoing* emails, Bradshaw's deficiencies are equally apparent. As concerns the present claims, there is no indication anywhere that any of the steps identified in claim 83 are performed *by or for the author* to permit him/her to control the checking of content in an email message. Instead Bradshaw merely describes some kind of basic edge/gateway that does not coordinate or interact with the author/originators of the email messages. Hence, it cannot meet the language of these claims.

As further noted in a recent decision:

If we analogize claim construction to a painting, then *the Examiner uses too broad a brush*, construing the disputed limitation too broadly, and *glossing over its details*. Claim 1, step h recites "for each document of said database, calculating its geometric relative distance from a said node to derive one or more node attractors." Thus, the claim requires calculating the geometric relative distance from a node, as well as an attractor for each document. *The Examiner's finding that Nevin calculates "distance from a document node to a concept node" (Ans. 28) does not meet this limitation.*

See Appeal 2009-004118 (Decided December 11, 2009)(emphasis added). Similarly here the description in col. 12 in Bradshaw is simply too thin to support the conclusions now advocated by the Examiner, and he is clearly glossing over the details of the claim. Rejections based on 35 U.S.C. § 103 must rest on a factual basis. In making such a rejection, the examiner has the initial duty of supplying the requisite factual basis and may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. In re Warner, 379 F.2d 1011, 1017 (CCPA 1967). The Examiner here is resorting to substantial speculation to fill in large gaps in the teachings of the reference and thus Applicant submits that the current rejection should be withdrawn.

Dependent claims 84, 87 and 92 should be allowable for at least the same reasons.

Additional independent claims 94, 96, 100 and 101 should also be allowable for at least the same reasons as claim 83.

Claims 85 and 86 are patentable over Bradshaw in view of Cohen

These claims should be allowable for at least the same reasons as claim 83, from which they depend. Moreover, claim 86 recites that a plurality of filters could be triggered, and the method identifies which one is implicated. There is no such feature in Cohen, which uses a single dictionary. There is no teaching or suggestion anywhere that one skilled in the art would incorporate the same in Bradshaw as the latter is not remotely related to informing authors/originators of emails of anything – it simply intercepts their input and locks them out of further data entry when users input an item that is within the sentinel libraries. It offers no explanation - let alone guidance to an author – of which language filter was tripped and thus teaches away from any incorporation of Cohen's scheme.

Claims 88, 89 and 97 are patentable over Bradshaw in view of Stamps

These claims should be allowable for at least the same reasons as claim 83, from which they depend. Moreover, claim 89 recites that the *language filter* has foreign words; the Stamps reference merely explains that the *spell checking* dictionary may be of a different language. Since Stamps neither teaches nor suggests that it can be used as a foreign language filter, Applicant submits that this very real deficiency as a reference makes its value marginal in combination with Bradshaw. It is not a language “filter” as set out in the claims, and combining it with Bradshaw would not therefore result in the invention of claim 89.

Moreover the Examiner's sole basis for arguing the combination of claim 89 is contained in the following statement: “...the motivation for doing so would have been to have correct spelling and improper foreign language words.” See page 18 of the Office Action. With all due respect, this argument is conclusory and simply parroting almost word for the word the claim language as presented by the Applicant. Hence, on its face it is clearly merely hindsight reasoning and not sufficient to support an obviousness rejection. This is apparent too from recent BPAI decisions disapproving of such approach, including the following from Appeal 2009-004853 (Decided: January 25, 2010):

The Examiner then asserts that “Amstein discusses a server in col. 20, lines 13-16 which could be used to perform this step in claim 1,” and that “*it would have been obvious* to one having ordinary skill in the art at the time the invention was made to

incorporate the server being identified by the requested domain name with the identified server having a redirected domain name *because such feature would make the web pages (HTML files) available to be viewed by the web browser at a redirected web site on the Internet*" (Examiner's Ans. 6-7). However, these are mere conclusory statements that modifying Amstein would result in the aforementioned recitation of independent claims 1, 8, 15, 16, 22, and 28, without the required articulated reasoning with rational underpinnings as to why one of ordinary skill would modify Amstein to include these recitations. See In re Kahn, 441 F.3d at 988. Accordingly, as the Examiner has not provided a proper case of prima facie obviousness, we will not sustain the rejections of independent claims 1, 8, 15, 16, 22, and 28, and the rejections of their dependent claims 2, 3, 5-7, 9, 10, 12-14, 17, 18, 20, 21, 23, 24, 26, 24 and 27. (emphasis added)

The Examiner's "evidence" for motivation here is identical to that used by the Examiner in the decision above and was expressly rejected. He is merely repeating the language of the claims as support for the motivation/modification, which is deficient as a matter of law to support the rejection.

Claims 90, 91, 93, 98 and 99 are patentable over Bradshaw and Russell – Falla

The Examiner again suggests that Russell-Falla shows "thresholds" but he fails to note that these not thresholds being used by an author of an email message; they are thresholds being used by a web surfer looking at web pages for an entirely different purpose. Hence they do not meet the language of the claims, and "combining" it with Bradshaw therefore would not even yield the claimed combination.

Moreover the Examiner provides *no* rationale for combining the references, again, except to repeat the claim language: "...the motivation for doing so would have to allow user designate a threshold to filter content" (page 20 of Office Action). Again this is effectively simply an argument based on a recitation of the claim language. As noted earlier, Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning. KSR, 550 U.S. at 417-418, quoting In re Kahn, 441 F.3d 977, 988 (Fed. 2006). Here, the Examiner has made no findings as to how such a modification to the combination would occur other than to say the modification would result in the invention described in the language of the claims.

Claims 95 and 102 - 103 are patentable over Bradshaw taken with Rayson

The Applicant has already provided an explanation for why the references do not add up to the claimed combination, and thus incorporates by reference the prior discussions. More importantly, as with the other §103 rejections, the Examiner provides no rationale for combining the references, again, except to repeat the claim language: "...the motivation for doing so would have been to automatically scan an entry immediately as input..." (page 21 of Office Action).

As noted earlier, this is not sufficient to sustain an obviousness rejection since it merely argues that the motivation for the combination is in fact the invention described in the language of the claims. This is classic hindsight reasoning which is still not an acceptable methodology for rejecting claims. See In Re Ravi Vaidyanathan, ___ F.3d ___ (Fed. Cir. May 19, 2010):

As the applicant states, while *KSR* relaxed some of the formalism of earlier decisions requiring a "teaching, suggestion, or motivation" to combine prior art references, it did not remove the need to anchor the analysis in explanation of how a person of ordinary skill would select and apply the teachings of the references.

The applicant complains that the Board simply reasoned from the hindsight knowledge of his successful invention; he stresses that, unlike the facts in *KSR*, the various steps that he combined were not known to be combinable, and the result of increased precision in missile guidance to the target was not previously known or predictable.

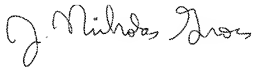
Obviousness is determined as a matter of foresight, not hindsight. See id. at 421 (citing *Graham*, 383 U.S. at 36). *KSR* did not free the PTO's examination process from explaining its reasoning. In making an obviousness rejection, the examiner should not rely on conclusory statements that a particular feature of the invention would have been obvious or was well known. Instead, the examiner should elaborate, discussing the evidence or reasoning that leads the examiner to such a conclusion.

Applicant submits that the Examiner's rejection, which simply borrows from the claim language, is clearly just hindsight reasoning. There is no attempt to elaborate on the combination except to argue that the two references could be combined.

CONCLUSION

The references and rejections have been addressed in detail, and Applicant submits that the Application is in condition for allowance based on the prior amendments. A petition for an extension of time is also enclosed. Please charge the fees due to deposit account no. 501-244.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "J. Nicholas Gross".

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